



UNITED STATES PATENT AND TRADEMARK OFFICE

SW

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,142	06/30/2000	Luigi Forlai	7704.0001	2446

22852 7590 02/04/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

Office Action Summary

Application No.

09/609,142

Applicant(s)

FORLAI, LUIGI

Examiner

Narayanswamy Subramanian

Art Unit

3624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 16-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 3624

DETAILED ACTION

1. This office action is in response to communication from the Applicant dated December 29, 2003. Claims 1-61 are pending in this application. The Examiner acknowledges provisional election of claims 1-15 by the Applicant. Claims 16-61 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is respectfully advised to cancel the non-elected claims in response to this office action. Elected claims 1-15 have been examined. The objections and rejections are stated below.

Drawings

2. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings of figures 5-21 will be required when the application is allowed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

Art Unit: 3624

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Odom et al (US Patent 6,058,379).

With reference to claim 1, Odom teaches a method of making a sale offer over an electronic network system, comprising the steps of: randomly generating an offer to purchase a product or service on the electronic network system (See Odom Column 3 lines 20-26); communicating the randomly generated offer through the electronic network system for a predetermined period of time to one or more potential buyers connected to the electronic network system (See Odom Column 3 lines 20-26 and Column 5 lines 46-50); completing the sale of the product or service through the electronic network system in response to an acceptance of the offer by a buyer within the predetermined period of time (See Odom Abstract and Column 3 lines 43-46); and removing the offer from the electronic network system should the buyer not accept the offer within the predetermined period of time (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67). Posting information on the Web and sending e-mail to notify implies randomly generating and communicating an offer.

With reference to claim 2, Odom teaches a method for using an electronic network system to facilitate a transaction between a seller and a buyer, said method comprising the steps of: inputting a sale offer parameter for randomly generating at least one sale offer to purchase a product or service (See Odom Column 3 lines 20-26); randomly displaying, through the electronic network system, the at least one sale offer to a selected buyer at an unexpected period

Art Unit: 3624

of time (See Odom Column 3 lines 20-26 and Column 5 lines 46-50); and withdrawing the display of the randomly generated sale offer in response to an absence of an indication of acceptance of the randomly generated sale offer by the buyer within a predetermined period of time after the step of displaying the randomly generated sale offer (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67). Posting information on the Web and sending e-mail to notify implies displaying at an unexpected period of time. The seller can withdraw at any time at seller's option, which includes withdrawing in response to an absence of an indication of acceptance of the offer by the buyer within a predetermined period of time.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al (US Patent 6,058,379)

With reference to claims 3, 5 and 6, Odom teaches a method of claim 2 as discussed above. Odom also teaches the steps wherein the step of randomly displaying the at least one sale offer includes displaying the at least one sale offer to a buyer at a plurality of alternative time periods selected by the seller and unknown to the buyer (See Odom Column 5 lines 33-38); wherein the step of randomly generating the at least one sale offer includes the step displaying

Art Unit: 3624

the at least one sale offer to a buyer over a predetermined period of time determined by the seller and unknown to the buyer (See Odom Column 5 lines 33-38) including the step of displaying the at least one sale offer to a buyer selected by the seller (See Odom Column 5 lines 48-50). Since the seller can list items, modify/remove items, intervene in an exchange at the option of the seller, these steps imply randomness and are known only to the seller and unknown to the buyer. E-mailing to potential purchasers implies displaying the offer to a buyer selected by the seller.

With reference to claim 4, Odom teaches a method of claim 2 as discussed above.

Odom does not explicitly teach the step of providing a random frequency device for displaying the at least one sale offer in an unpredictable manner.

Official notice is taken that the step of providing a random frequency device for displaying random offers is old and well known in the art. These devices like pop-up ads generate offers that sometimes results in a sale. This helps the seller increase his/her potential sales without requiring seller intervention.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine this step to the disclosure of Odom. The combination of the disclosures taken as a whole, suggests that sellers would have benefited from the potential for increased sales without requiring seller intervention.

With reference to claims 7-15, Odom teaches a method of claim 2 as discussed above further comprising the steps of receiving, through the electronic network system, a first indication of acceptance from the buyer in response to the display of the at least one randomly generated sale offer; displaying at least one term associated with the at least one randomly generated sale offer in response to the first indication of acceptance; receiving a second

Art Unit: 3624

indication of acceptance from the buyer in response to the display of the at least one term associated with the at least one randomly generated sale offer (See Odom Column 6 lines 28-33 and lines 52-58); displaying at least one payment method option in response to the indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; transferring a sum corresponding to the selected payment method from the buyer to the seller; and requesting delivery of the offered product or service to the buyer (See Odom Column 3 lines 43-46). The best bids are displayed to the bidders and the window for making a bid implies opportunities to make repeated bids within a predetermined time. The Clearing process and mechanisms are interpreted to include the steps of displaying at least one payment method option in response to the indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; transferring a sum corresponding to the selected payment method from the buyer to the seller; and requesting delivery of the offered product or service to the buyer. Alternatively these steps are old and well known in the art. These steps help in the speedy and smooth conclusion of the transaction. Odom also teaches the step wherein an offer price substantially equal to a delivery price associated with the sale offer transaction and an offer price substantially equal to a discounted value less than a market value of the offered product or service plus a delivery price associated with the sale offer transaction (See Odom Column 2 lines 7-8). Since the seller sets the selling price, it can be any price including a delivery price or a discounted price. Odom further teaches the steps of withdrawing the at least one randomly generated sale offer in the event the buyer does not indicate acceptance within a predetermined period of time after the step of displaying the at least one randomly generated sale offer (See

Art Unit: 3624

Odom Column 5 lines 33-38); withdrawing the at least one randomly generated sale offer in the event the buyer does not indicate acceptance within a predetermined period of time after the step of displaying the at least one term associated with the at least one randomly generated sale offer (See Odom Column 5 lines 33-38); and determining if a predetermined monetary amount is available to transfer from the buyer to the seller (See Odom Column 11 lines 22-26).

Odom does not explicitly teach the steps of displaying an acceptance form forming a purchase agreement to the buyer in response to an indication of acceptance from the buyer and receiving an indication of acceptance from the buyer in response to the display of the acceptance form; payment method option comprising a credit card payment option or a cash-upon-delivery payment option; withdrawing the offer in the event the buyer does not indicate acceptance within a predetermined period of time after the step of displaying the acceptance form or a payment method option.

Official notice is taken that these steps are old and well known in the art. These steps provide for smooth negotiations between the buyer and the seller, ensures payment to the seller and helps the seller withdraw the offer in case the buyer is not able to meet the seller's criteria.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine these steps to the disclosure of Odom. The combination of the disclosures taken as a whole, suggests that sellers would have benefited from ensuring payment for the transaction and being able to withdraw the offer in case the buyer is not able to meet the seller's criteria and both buyers and sellers would have benefited from the smooth negotiations as a result of inclusion these steps.

Art Unit: 3624


Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
January 23, 2004

 Richard Weisberger
Primary Examiner